UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,124	09/09/2003	Venkatapathi R. Nallapa	130209.511	9695

500 7590 09/22/2005	EXAMINER
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092	ELMORE, STEPHEN C

	ART UNIT	PAPER NUMBER
	2186	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	10/658,124	NALLAPA, VENKATAPATHI R.
	Examiner	Art Unit
	Stephen Elmore	2186

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 September 2003</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>1-9,11-15,17,18 and 20-23</u> is/are allowed.

6)☒ Claim(s) <u>10,16,19 and 24-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>September 9, 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

STEPHEN C. ELMORE
PRIMARY EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/18/03, 2/23/05</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Office action responds to the application filed September 9, 2003 and the preliminary

amendment, filed February 23, 2005, amending claims 1-4, 9, 11-14, and 16-24.

2.   Claims 1-28 are presented for examination.

Specification

3.   The disclosure is objected to because of the following informalities:

        a.   page 7, line 25 -- the Specification makes reference to "the second sector 26", but this

contradicts the reference made to "the sixth sector 26" at page 8, line 10 -- which sector is the correct

sector, the second or the sixth?;

        b.   the Specification uses potentially trademarked products which, if so, the trademarked

products should be capitalized wherever they appear and be accompanied by the generic terminology.

        Although the use of trademarks is permissible in patent applications, the proprietary nature of

the marks should be respected and every effort made to prevent their use in any manner which might

adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process
> of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled
> in the art to which it pertains, or with which it is most nearly connected, to make and use the same
> and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 10, 16, 19 and 24 are rejected under 35 U.S.C. 112, first paragraph, because the

specification, while being enabling for the feature (which has not yet been claimed), using Claim 10

language as exemplary,

        determining a location of a most recent one of the sets of data upon a power up event

(Claim 10)

        this distinction is demonstrated by Applicant's element 168 of Figure 5, and is discussed

beginning at page 10, line 13 of the Specification,

and although the Specification is enabling of the above feature, however, it does not

reasonably provide enablement for the actually claimed feature, using Claim 10 language as

exemplary,

determining a most recent one of the sets of data upon a power up event (Claim 10)

Claims 16, 19 and 24 exhibit the same type of problem in scope of enablement although slightly

different language is used in each of these claims.

The specification does not enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to make and or use the invention commensurate in scope with these

claims.

Using Claim 10 as exemplary, the determination step as disclosed in the Specification, at the

location already noted above, does not determine the most recent sets of data, but instead determines

the location of that data. Claims 16, 19 and 24 have the same type of problem in claim scope

enablement.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

7.   Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. The claims are indefinite because:

a.   Claim 25 -- the language,

"a data structure comprising: a plurality of sets of contiguous memory"

is unclear in scope of meaning, this does not logically make sense because a data structure is

only an arrangement of data (for example, arranged according to some plan or convention) which is

stored in a computer readable medium (such as sets of contiguous memory, which can mean portions of

a sector of Flash Ram), this explanation distinguishes the difference between a data structure which is

stored in memory (hardware) versus the claim for a data structure which is memory (hardware),

consequently, the existing claim language appears to be trying to claim that a data structure is a

plurality of sets of contiguous memory, but this is not the case with data structures because data

structures are not memory, they are merely data objects that are stored in memory;

      b.   Claim 25 -- the language,

"each bit indicative of a defined location of...the sets of contiguous memory"

is indefinite as being incomplete for omitting essential elements and/or structural cooperative

relationships, such omission amounting to a gap between the elements. See MPEP § 2172.01. The

omitted elements and/or structural cooperative relationships are:

      1) a bit(s) position, and

      2) the respective bit position being read and interpreted by (for example) a processor,

      without the bits being read and interpreted by a processor or controller in a computer

processing system, the bit or bits, and the positions of the bits, are not capable of indicating

anything, the bit by itself cannot indicate anything, the bit(s) must be read and interpreted by

a processor, according to their respective bit positions, by the processor executing an

appropriate set of instructions for performing this interpretative activity in order for the

position of the respective bit(s) to be interpreted to signify a defined location of sets of

contiguous memory;

      c.   Claim 27 -- the language,

"the offset is a multiple of a position of the bit in the pointer"

is not clear in scope of meaning because it is unknown what is meant by "a multiple of the

position of the bit" -- how can a position have a multiple? A secondary problem is that an "offset" is

already a known term in the art having a well-defined meaning, but this language appears to be trying

to redefine what an offset is, however, Applicant is not permitted to use a term in the art in a manner

that is repugnant to it's normal meaning, that is, to use a term in the art in such a way as to redefine it

away from it's dictionary meaning.

      Claims 26-28 inherit the deficiency of the preceding claim in the claim dependency chain.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9.   Claims 25-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02, "The claimed invention as a whole must accomplish a practical application." See MPEP 2106.

In the instant case, Claim 25 taken as a whole is directed to a Flash memory storing a pointer data structure, however, the data structure in the Flash memory is not used in the claim for any practical purpose or application, the data structure is merely dormant in the claim and so has no practical functionality because the data structure is not used by any controller or processor accessing the Flash memory in conjunction with appropriate controlling instructions to effect some useful result, there is no result from the data structure it merely exists as a stored data object, and so, because the stored data object is never used the claim lacks any practical application or credible utility since none is asserted.

Claims 26-28 contain no limitation which overcomes the deficiency of Claim 25 and so inherit the deficiency of the independent claim from which they depend.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11.   Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Hara, Japanese Patent Publication 08-017192.

Hara teaches the claimed flash memory containing a data structure of a pointer at a fixed location in the flash memory where bits of the pointer indicate defined locations of sets of contiguous memory, see Abstract.

Allowable Subject Matter

12.   Claims 1-9, 11-15, 17, 18, and 20-23 appear allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Elmore whose telephone number is (571) 272-4436. The examiner can normally be reached on Mon-Fri from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 18, 2005

**STEPHEN C. ELMORE
PRIMARY EXAMINER**